

Bankstahl et al.

S/N: 10/064,344

ELECTION

Applicants elect, with traverse, what the Examiner has characterized as "Invention I", deemed drawn to a manifold apparatus and method, and corresponding to claims 1-8 and 14-17.

REMARKS

The Examiner has identified three 'inventions' in the pending claims. The Examiner's classification of the 'inventions' include Group I consisting of claims 1-8 and 14-17 drawn to a manifold apparatus and method and classified by the Examiner in class 137, subclass 884, Group II consisting of claims 9-13 drawn to a compressor and classified by the Examiner in class 417, subclass 2, and Group III consisting of claims 18-22, drawn to a welder and compressor and classified by the Examiner in class 219, subclass 133.

In setting forth the restriction, the Examiner states that:

Inventions II, III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it is recited without. The subcombination has separate utility such as a manifold for another use.

Applicant does not necessarily disagree that Groups I, II, and III are related as combination/subcombinations; however, an examination of the elements of the claims, rather than merely the preamble, evidences the interrelation therebetween. MPEP §806.05(c) states that "[i]f there is no evidence that combination ABsp is patentable without the details of Bsp, restriction should not be required." (Emphasis added). MPEP §806.05(c) further states that "[w]here the relationship between the claims is such that the separately claimed subcombination Bsp constitutes the essential distinguishing feature of the combination ABsp as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility." (Emphasis added).

Using the nomenclature of MPEP §806.05(c), it is apparent that Groups I, II and III are related as Bsp/ABsp/ABsp, respectively. Claims 1 and 14 each call for, in part, a unitary manifold block and a first and a second fluid communication system. Similarly, claim 9 of Group II also calls for a unitary manifold block, a first fluid communication system, and a second fluid communication system. Likewise, claim 18 of Group III also calls for a manifold, a first fluid

Bankstahl et al.

S/N: 10/064,344

communication system, and a second fluid communication system. Additionally, claims 1, 9, 14, and 18 each call for a manifold having a first main inlet port and a second main inlet port. It is apparent that the Examiner has imposed a restriction and categorized the claims based solely on the preamble of the respective claim Groups. An examination of the elements contained in the body of each of the respective claims clearly evidences the interrelation between the independent claims of the claim groups. As such, it is apparent that claims 1 and 14, 9, and 18 are related as Bsp/ABsp/ABsp. Therefore, in accordance with MPEP §806.05(c), restriction between the claim groups of the present application is not proper.

Additionally, the Examiner states that "a subcombination has separate utility such as a manifold for another use." In order to impose a restriction, MPEP §806.05(c) requires the Examiner suggest utility other than the utility of the combination. MPEP §806.05(c) further states that "the burden is on the Examiner to suggest an example of separate utility." (Emphasis added). Merely stating that the manifold has "another use" is not an example of separate utility as required under MPEP §806.05(c).

For all these reasons, Applicant respectfully requests rejoinder of all claims, of each group. The Examiner is invited to call the undersigned to discuss this Response or any other matters regarding this application to further prosecution.

Respectfully submitted,



Timothy J. Ziolkowski
Registration No. 38,368
Direct Dial 262-376-5139
tjz@zpspatents.com

Dated: April 1, 2004
Attorney Docket No.: ITW7510.012

P.O. ADDRESS:

Ziolkowski Patent Solutions Group, LLC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170